

REMARKS

Claims 1-19, 23-24, 26-28 and 95 are pending. Applicants elect with traverse Group I and SEQ ID NO:1 (claims 1-19) for examination on the merits. The claimed method requires comparing recognition of “a protein from said agent having a length of at least 30 amino acid” (i.e., ESAT-6) and “one or more peptide epitopes from the agent” (i.e., SEQ ID NO:1). For the convenience of the Examiner, it is noted that the peptide consisting of the amino acid sequence of SEQ ID NO:1 is derived from ESAT-6 (see claim 15). Applicants reserve the right to prosecute nonelected subject matter in a further patent application.

Notwithstanding the above election, reconsideration of the restriction requirement is requested because examination of all pending claims would not constitute a serious burden. In particular, the claims of Group I directed to a diagnostic method and Group IV directed to a kit specifically designed for practicing the diagnostic method should be examined in the same application. Thus, at least claims 27-28 should not be withdrawn from consideration.

Applicants disagree with the allegation in the Action that claims 1-19 and 27-28 lack unity of invention, and therefore belong to different groups of inventions. Although they agree with the Examiner’s conclusion that the inventions are separately patentable, Applicants’ traversal is based on claims 1-19 and 27-28 being so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, Applicants submit that claims 1-19 and 27-28 should be examined together in this application. It was alleged on page 3 of the Action that WO 00/26248 discloses the invention of Group I. But the cited document is not evidence of a lack of unity because while it discloses amino acid sequences of certain peptides, WO 00/26248 does not teach or suggest the invention of Group I which is directed to the diagnostic method generically recited in independent claim 1.

Applicants submit that, in accordance with the M.P.E.P., the claims identified by the Examiner as Groups I and IV are linked to form a single general inventive concept. In particular, the Examiner’s attention is directed to M.P.E.P. § 1850 III A Combinations of Different Categories of Claims (8th Ed., Rev. 5, August 2006), which states at 1800-96 to 1800-97:

The method for determining unity of invention under Rule 13 PCT shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: . . .

(B) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process . . .

[A]n apparatus or means shall be considered to be specifically designed for carrying out a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression “specifically designed” does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

It was alleged in the Action that the inventions listed by the Examiner as Groups I and IV do not relate to a single general inventive concept because they lack the same or corresponding special technical features under PCT Rule 13.2. But here, the special technical feature linking claims 1-19 and 27-28 shows that the claimed method can be practiced using the components of the claimed kit. In accordance with the section of the M.P.E.P. quoted above, Group I (claims 1-19) is directed to the process and Group IV (claims 27-28) is directed to the kit “specifically designed” for carrying out that process. Applicants’ specification teaches that the claimed kit is specifically designed for carrying out the claimed diagnostic method. Therefore, Applicants submit that claims 1-19 and 27-28 have unity of invention in accordance with PCT Rule 13 as discussed in M.P.E.P. § 1850. Accordingly, Applicants submit that there is no lack of unity as regards to claims 1-19 and 27-28.

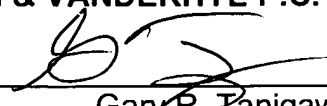
Finally, Applicants note that independent claim 1 is a generic claim in this patent application for proteins and their peptide epitopes. No specific proteins or amino acid sequences are recited in claim 1 and the claimed diagnostic method is applicable to a broad genus of proteins and amino acid sequences. Examination should thus proceed under the provisions of M.P.E.P. § 809 instead of requiring restriction among the amino acid sequences of peptides recited in claim 16.

Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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